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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/774,976      | 02/09/2004  | Wayne Belcher        | 20108/0200867-US0   | 9594             |

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| EXAMINER |
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LUK, EMMANUEL S

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| ART UNIT | PAPER NUMBER |
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1722

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 01/10/2007 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/774,976

Applicant(s)

BELCHER, WAYNE

Examiner

Emmanuel S. Luk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 11 and 13-23 is/are pending in the application.
- 4a) Of the above claim(s) 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 11, 13-17 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's request for reconsideration of the finality of the rejection from the discussion in light of the applicant's comments that examiner had overlooked the amendment of claim 14 in the last office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification lacks reference to a cutting edge or lack of cutting edge of the applicator portion. The specification teaches a tip width, however, there is no mention of the width functioning as a cutting edge or a non-cutting edge.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "cutting edge" is unclear since a plastic fork with dimensions with an edge similar to the dimensions stated in the specification of .05 inches (~1.27 mm) can be used to cut items of sufficient hardness. It is unclear how the applicant's sealant tool is without an edge capable of "cutting".

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 6, 8, 16, 17, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Julien (6293020).

Julien teaches a tool having a handle with substantially planar configuration (42) with an elongated applicator portion (34) that is fixed at one end with the handle and transitioning linearly outward along a longitudinal axis of the handle and applicator portion (Fig. 1, Fig. 2), and further transitioning toward a single free end tip (52) and decreases from the longitudinal axis towards lateral edges of the applicator portion (Fig. 1, Fig. 2, Fig. 3), the external surface of the applicator portion is symmetrically convex with an aggressive shaped curvature (52).

The use of the tool for sealant application is an intended use of the apparatus.

Julien teaches the structures of the claimed invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 2, 3, 7, 10, 11, 13, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julien as applied to claim 1 above, and further in view of Arnett (DE 31965).

Julien fails to teach the handle and applicator from the same material and integrated and a passive curvature. Julien does teach of the knife blank 350 having the shape of the blade and the handle prior to additional material is placed upon for ease of grip (Fig. 30).

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Arnett teaches a tool having a handle (1) of a planar configuration, and a planar applicator portion (2) that is fixed to the handle with a free tip section (4) having a spline radius. The handle and applicator portion are the manufactured the same and are integrated. The tip having a passive shaped curvature and the handle surface appears smooth.

It would have been obvious for one of ordinary skill in the art to modify Julien with the passive curvature shape as taught by Arnett because it is a design choice in the shape of the tip. In regards to the handle and blade being of one integrated material, Arnett teaches a blade that is capable of being constructed and thus it would have been obvious for one ordinary skill in the art to modify Julien with the handle and applicator being the same material as taught by Arnett because of ease in manufacturing.

In regards to claims 13 and 15, these are dimensions to the tool that can be varied according to design choice. Claim 16 is also based primarily upon design and user choice since comfortable gripping is determined more upon the particular user.

11. Claim 5 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Julien as applied to claims 1 and 21 above, and further in view of Cacossa (5759590).

Julien fails to teach the construction material of the handle and the applicator.

Cacossa teaches that the handle can be made out of plastic, wood, metal, or the like (Col. 4, lines 22-26), and the blade structure can be made from metallic material, from plastic, or other substantially rigid material (Col. 4, lines 27-35).

It would have been obvious to one of ordinary skill in the art that the tool taught by Arnett is made from a material such as plastic or metal as these are common materials to construct tools.

### ***Response to Arguments***

12. Applicant's arguments, filed 7/28/06, with respect to the rejection(s) of claim(s) 1 and 21 under Arnett have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Julien. The 35 USC 102(e) rejection based upon Arnett have been considered and the applicant's arguments concerning the claimed limitations have been persuasive. However, newly found reference, Julien, teaches the claimed structure including the transitioning linearly outward from the handle and the symmetrical convex shape that the applicants have previously pointed out. The new rejection addresses the claimed shape of the applicator and handle. The use of the applicator and handle is an intended use and there is a reason to combine the new reference of Julien with the other references due to blade shape and construction.

### ***Conclusion***


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel S. Luk whose telephone number is (571) 272-1134. The examiner can normally be reached on Monday-Fridays from 9 to 5.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra N. Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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